

REMARKS

By this amendment Applicant cancels claims 20-27, 30, 31, and 33; amends claims 1, 28, and 32 to more clearly define the present invention; amends claims 4-6 to improve form; and adds new claim 34 to claim subject matter to which the Applicant is entitled.

Claims 1-19, 28, 29, 32, and 34 are currently pending.

In the Office Action mailed July 23, 2004, the Examiner acknowledged Applicant's priority claim to U.S. Provisional Application No. 60/225,305; indicated that the Information Disclosure Statement filed April 22, 2002 failed to comply with 37 CFR 1.98(a)(3) because it did not include a concise explanation of relevance for non-English document DE 4428729 A-1; objected to claim 12 under 37 CFR 1.75(c) as failing to further limit the subject matter of a previous claim; rejected claims 1, 7-9, 12, 19, 28 and 32 under 35 U.S.C. § 102(b) as anticipated by P. Stockl, GSM/DCS Coverage Measurement Systems (hereinafter Stockl); rejected claims 2-4, 6, and 29 under 35 U.S.C. § 103(a) as unpatentable over Stockl; rejected claims 13-16 under 35 U.S.C. § 103(a) as unpatentable over Stockl in view of U.S. Patent 5,960,341 to LeBlanc et al. (hereinafter LeBlanc); and objected to claims 5, 10-11, and 17-18 as being dependent on a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claims and any intervening claims.

Applicant files herewith an Information Disclosure Statement citing, inter alia, an Office Action mailed July 7, 2004 for a co-pending Divisional Application No. 09/987,111 including original claims 20-27, 30, 31, and 33.

Concerning the Information Disclosure Statement filed April 22, 2002, Applicant submitted a copy of the English language search report from the European Patent Office in lieu of a statement of relevance of non-English document DE 4428729 A-1. M.P.E.P. 609(A)(3) ("Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report."). For the Examiner's convenience, Applicant has attached a copy of the Information Disclosure Statement filed April 22, 2002, including the search report and a post card as evidence of receipt.

Concerning the objection of claim 12, claim 12 recites the term "plurality," which does not appear in the recitations of claim 1. Therefore, claim 12 further limits claim 1, and the Examiner's objection under 35 CFR 1.75(c) should be withdrawn.

The Examiner rejected claims 1, 7-9, 12, 19, 28, and 32 under 35 U.S.C. § 102(b) as anticipated by Stockl. Applicant traverses this rejection.

Claim 1 defines a method for processing signal strength information from a radio frequency transmitter. Claim 1 recites a combination of steps including, *inter alia*, "dividing the received signal strength information into one or more subsets of signal strength information, such that the one or more subsets are determined based on a speed of a receiver of the received signal strength information."

In contrast to claim 1, Stockl statistically evaluates signal coverage measurements by “averaging over user-defined intervals.” (Stockl, p. 324, right column). Because Stockl teaches an approach based on “user-defined intervals” rather than the speed of a receiver, Stockl fails to disclose at least the claim 1 step of “dividing the received signal strength information into one or more subsets of signal strength information, such that the one or more subsets are determined based on a speed of a receiver of the received signal strength information.” Therefore, claim 1 is not anticipated by Stockl, and the rejection of claim 1 under 35 U.S.C. § 102(b) should be withdrawn.

Claims 7-9, 12, and 19 depend, either directly or indirectly, on allowable claim 1. Each of claims 28 and 32, although of different scope, include recitations that are similar to those of allowable claim 1. For at least the reasons given above with respect to claim 1, claims 7-9, 12, 19, 28, and 32 are not anticipated by Stockl, and the rejection of those claims under 35 U.S.C. § 102(b) should be withdrawn.

The Examiner rejected claims 2-4, 6 and 29 under 35 U.S.C. § 103(a) as unpatentable over Stockl. Applicant traverses this rejection.

Claims 2-4 and 6 each depend from claim 1 and include all the steps and recitations therein including, inter alia, “dividing the received signal strength information into one or more subsets of signal strength information, such that the one or more subsets are determined based on a speed of a receiver of the received signal strength information.” For at least the reasons given above with respect to claim 1, claims 2-4, and 6 are thus allowable over Stockl. Moreover, the Examiner’s modifications to Stockl

fail to cure its deficiencies. Therefore, claims 2-4 and 6 are allowable over Stockl, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Claim 29 depends from claim 28 and includes all the elements and recitations therein including, inter alia, "means for dividing the received signal strength information into one or more subsets of signal strength information, such that the one or more subsets are determined based on a speed of a receiver of the received signal strength information. For at least the reasons given above, Stockl does not disclose or suggest this element. Moreover, the Examiner's modifications to Stockl fail to cure its deficiencies. Therefore, claim 29 is allowable over Stockl, and the rejection of claim 29 under 35 U.S.C. § 103(a) should be withdrawn.

Furthermore, the Examiner acknowledges Stockl does not explicitly teach the claim elements of each of claims 2-4, 6, and 29. However, the Examiner ignores the shortcomings of Stockl and then appears to take Official Notice to fill such clear gaps in Stockl since he does not offer support for such gap filling. Applicant disagrees and submits that the Examiner appears to be improperly taking Official Notice with respect to claims 2-4, 6, and 29. By taking Official Notice, the Examiner's statements are unsupported by factually-based evidence and constitute unsubstantiated generalizations of questionable relevance to Applicant's claims. Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice" ("Memorandum"). In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner

must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” (Memorandum, p. 3). Should the Examiner maintain the objection, Applicant submits that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to Official Notice and [allow Applicant] to challenge the assertion in the next reply after the Office Action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the objection. Absent a factual basis on the record for the Examiner’s taking of Official Notice, the rejection under 35 U.S.C. § 103(a) of claims 2-4, 6, and 29 should be withdrawn for this additional reason.

The Examiner rejected claims 13-16 under 35 U.S.C. § 103(a) as unpatentable over Stockl in view of LeBlanc. Applicant traverses this rejection.

Each of claims 13-16 depend from claim 1 and include all the steps and recitations therein including, *inter alia*, “dividing the received signal strength information into one or more subsets of signal strength information, such that the one or more subsets are determined based on a speed of a receiver of the received signal strength information.” For at least the reasons given above with respect to claim 1, claims 13-16 are allowable over Stockl. Although LeBlanc teaches the use of a sliding window (LeBlanc at Fig. 13), such disclosure fails to overcome the above-described deficiencies of Stockl. Claims 13-16 are thus allowable over Stockl and LeBlanc, either taken alone or in combination, and the rejection of claim 13-16 under 35 U.S.C. § 103(a) should be withdrawn.

Moreover, a *prima facie* case of obviousness has not been made by the Examiner. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a),

each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001)). As noted above, neither Stockl nor LeBlanc discloses or suggests each recited claim element. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. For this second prong, the Examiner has merely used impermissible hindsight reasoning to reconstruct the Stockl reference, which makes no mention of LeBlanc's Bollinger Bands, which the Examiner improperly uses as motivation to combine. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Concerning this third prong, the Examiner has also failed to make any showing. Moreover, each of the prima facie obviousness requirements must be found in the prior art, and not be based on Applicant's disclosure. (See M.P.E.P. § 2143 (8th ed. 2001)). Absent a showing by the Examiner, the rejection of claims 13-16 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Regarding new claim 34, Applicant submits that new claim 34, by reason of its dependency from allowable claim 1, is neither anticipated nor rendered obvious in view of the cited art.

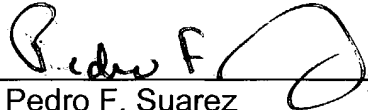
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 5, 2004

By: 
Pedro F. Suarez
Reg. No. 45,895

Attachments: Copy of Information Disclosure Statement filed April 22, 2004
(with postcard receipt)

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JK/PFS

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PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Nicolae G. COTANIS

Application No.: 09/929,034

Group Art Unit: 2681

Filed: August 15, 2001

Examiner: Unknown

For: SYSTEMS AND METHODS FOR DETERMINING SIGNAL COVERAGE

1. Second Information Disclosure Statement;
2. Form 1449;
3. International Search Report; and
4. 4 cited references.

Dated April 22, 2002

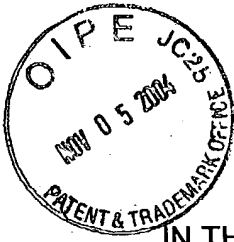
Docket No.: 05929.0016-00

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PATENT
Customer No. 22,852
Attorney Docket No. 5929.0016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Nicolae G. COTANIS

Application No.: 09/929,034

Filed: August 15, 2001

For: SYSTEMS AND METHODS FOR
DETERMINING SIGNAL
COVERAGE

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) Group Art Unit: 2681
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) Examiner: Unknown
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Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

SECOND INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), applicant brings to the attention of the Examiner the documents listed on the attached PTO 1449. This Information Disclosure Statement is being before the mailing date of a first Office Action on the merits for the above-referenced application.

Copies of the listed documents are attached.

Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

In lieu of a statement of relevance or translation of the non-English documents, an English language version of a search report from the European Patent Office in a

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

corresponding application citing these documents and setting forth the relevance thereof is enclosed.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and applicant determines that the cited documents do not constitute "prior art" under United States law, applicant reserves the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

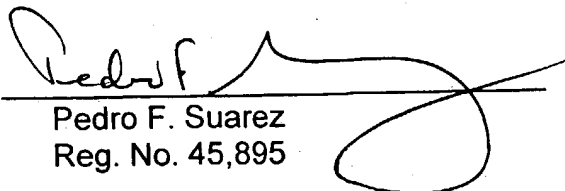
Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 22, 2002

By: 
Pedro F. Suarez
Reg. No. 45,895

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	5929.0016	Serial No.	09/929,034	RECEIVED
Applicant	Nicolae G. COTANIS	NOV 10 2004		
Filing Date	August 15, 2001	Group:	2681	Technology Center 2600

U.S. PATENT DOCUMENTS

Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
	5,987,306	11/16/99	Nilsen et al.	455	67.1	
	6,081,717	6/27/2000	Shah et al.	455	446	

FOREIGN PATENT DOCUMENTS

Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No
DE 4428729 A1	1/23/97	Germany			No

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

P. Stockl, "GMS/DCS 1800 Coverage Measurement Systems", Proceedings of the Nordic Seminar on Digital Mobile Radio Communications, December 1, 1992, pages 323-330.

Examiner	Date Considered
*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce